



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,476	09/28/2000	Michihiro Ota	80376	8514

7590 01/28/2004

Welsh & Katz LTD
120 South Riverside Plaza
22nd Floor
Chicago, IL 60606-3913

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/672,476	OTA ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The claim rejection under 35 USC § 112 has been withdrawn.

Claim Rejections - 35 USC § 102

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Claims 1 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Deaton et al. (US 6,292,786).

Deaton et al. teach a method and system for generating incentives based on substantially real-time product purchase information, comprising:

As per claim 1,

Art Unit: 3629

- presenting point information issued for promotion of sale of merchandise to a user at the time of merchandise sale (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- transmitting to a center device said point information together with identification information for said user (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- receiving at said center device said transmitted information (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- totaling and managing at said center device said transmitted information (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- offering a prescribed service to said user corresponding to the points (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31).

As per claim 14, said method and system wherein said center device manages said user based on said transmitted identification information for said user (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31).

As per claim 15, said method and system wherein said center device permits the user to read point information stored and managed for said user in response to a request from said user (column 5, lines 12-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3629

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-5, 9, 16, 18-19 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Resnick et al. (US 6,185,545).

As per claims 2 and 16, Deaton et al. teach all the limitations of claims 2 and 16, except that the merchandise sales are performed by using a vending machine.

Resnick et al. teach a method and system for making payments for the purchase of goods or services at point-of-sale locations, wherein a point-of-sale is a vending machine (column 10, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deaton et al. to include that said point-of-sale is a vending machine, because it would allow to install said system in the locations where the assistance of a sales-representative or a cashier is not feasible or desirable.

Also, Deaton et al. teach:

As per claims 4 and 18, said method and system, wherein the presentation of said point information is performed by displaying said point information on a display unit connected to said point issuing device (column 6, lines 35-37).

As per claims 5 and 19, said method and system, wherein the presentation of said point information is performed by printing out said point information on a prescribed form from said point issuing device (column 6, lines 27-37; column 16, lines 16-20).

As per claim 9, said method and system, wherein said module code comprises code information to identify said point issuing device, and said center device manages a state of at least one of said point issuing device and the equipment performing sales of

Art Unit: 3629

said merchandise in which said point issuing device is provided, based on said module code (column 4, lines 15-36).

As per claims 15 and 24-25, said method and system wherein said center device permits the user to read point information stored and managed for said user in response to a request from said user (column 5, lines 12-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6-8, 17, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. and Resnick et al. in view of Hoffberg et al. (US 5,901,246).

As per claims 3 and 17, Deaton et al. and Resnick et al. teach said method and system wherein said point information comprises a module code related to said point issuing device (column 4, lines 15-36).

However, Deaton et al. and Resnick et al. do not teach encrypting of a secret code related to said points.

Hoffberg et al. teach a method and system for man-machine interface incorporating adaptive pattern recognition based control system, wherein financial information transmitted over the network is encrypted prior to presentation to the user

(Fig. 25; column 1, lines 14-24; column 33, lines 12-17; column 37, lines 59-67; column 60, line 51 through column 62, line 32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deaton et al. to include encrypting of information related to said points because it would enhance the security of the system, thereby make it more attractive to the customers.

As per claims 6-7 and 20-21, Hoffberg et al. teach said method and system, wherein the presentation of said point information is performed by inputting said point information to a communication equipment of said user, by means of communication between said point issuing device and said communication equipment, wherein said communication equipment comprises a portable telephone set carried by said user (column 110, line 46-58).

As per claims 8 and 22, Deaton et al. teach said method and system wherein said secret code comprises at least a point issue number, and said center device judges duplicate use of the point information based on said point issue number (column 18, lines 37-54).

As per claims 23, Deaton et al. teach said method and system wherein said center device comprises an equipment database to store and manage a state of at least one of said point issuing means and the equipment performing sales of said merchandise in which said point issuing means is provided, in correspondence with said module code (column 4, lines 15-36).

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Roshkoff (US 6,042,149).

As per claims 10-13, Deaton et al. teach all the limitation of claims 10-13, except for attaching in advance to a merchandise a printed matter on which said point information is printed, and that said point information is selectively concealed by a removable concealing member.

Roshkoff teaches a method and apparatus for delivering an incentive item, comprising a printed matter which is attached in advance to a merchandise with an incentive information printed on it, wherein said incentive information is selectively concealed by a removable concealing member (column 1, line 6 through column 5, line 26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deaton to include attaching in advance to a merchandise a printed matter on which said point information is printed and that said point information is selectively concealed by a removable concealing member because it would enhance the capability of the system thereby make it more attractive to the customers.

Response to Arguments

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

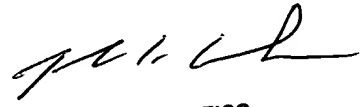
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JB


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600